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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/138,459	08/21/1998	SHOLOM S. ROSEN	0225-4161US1	4108

7590 12/31/2002

MORGAN & FINNEGAN  
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NEW YORK, NY 10154

EXAMINER

SONG, HOSUK

ART UNIT	PAPER NUMBER
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2131

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/138,459

Applicant(s)

ROSEN

Examiner

HO S. SONG

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Sep 12, 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 12-15 and 17-19 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 12-15 and 17-19 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 12-15,17-18 drawn to an electronic money transfer between electronic devices and transaction receipt is forwarded to one of electronic unit., classified in class 705 , subclass 39.
  - II. Claim 19, drawn to a tamper-proof device where it performs cryptographic operations such as generating public and private key pair and creates digital certificate, classified in class 713, subclass 194.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of claims 12-15,17-18 and 19 are related to as combination and subcombinations. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombinations as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations. (M.P.E.P. 806.05(c)). In the instant case, the combination of (I) does not require the particulars of the subcombination (II), because electronic transaction can be practiced without a tamper-proof key generator device of the claims. The subcombination has separate utility such as access control in order to achieve authentication from remote server and protect its data against intruders. Because these inventions are distinct for the reasons given above and have separate

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status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. These two separate classification is an indication of burden on the examiner as reason stated above.

3. An attempt to reach Mr. Rossi on 12/23/02 to request an oral election to the above restriction requirement, but was unsuccessful.


***Information Regarding Communication with the PTO***

3. Any inquiry concerning this communication or earlier communications from the examiner be directed to Hosuk Song whose telephone number is (703)305-0042. The examiner can normally be reached on Tues..-Fri.. from 6:00 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gail Hayes can be reached on (703)305-9711.

Any inquiry of a general nature or relating to the status of this application or preceding should be directed to Group receptionist, whose telephone number is (703)305-3900.

*Hosuk Song*

  
LY V. HUA  
PRIMARY EXAMINER